

REMARKS

In view of the following remarks, Applicants respectfully request reconsideration and allowance of the subject application. Claims 1-26 are original and are pending.

The §103 Rejections

Applicants submit that the Office has failed to establish a *prima facie* case of obviousness and respectfully traverse the Office's rejections of Claim 1-26. However, before discussing the substance of the Office's rejection a section entitled "The §103 Standard" is provided and will be used in addressing the Office's rejections. Following this section, a discussion of the disclosure and teachings of the relied upon references is provided.

The §103 Standard

To establish a *prima facie* case of obviousness, three basic criteria *must* be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Second, there must be a reasonable expectation of success. *In re Merck &*

Co., Inc., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

Hence, when patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine or modify the references relied on as evidence of obviousness. The need for specificity pervades this authority. *See, e.g., In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed").

The Mattingly Reference

Generally, Mattingly discloses a technique for automating installation of firmware upgrades within a networked peripheral device once the user has inserted a CD-ROM or other external data storage medium into the PC of the user's personal network. In operation, Mattingly teaches that an updated firmware for a base station 220 is loaded into the memory 260 of the PC 210. The firmware upgrade is loaded from a CD-ROM into the memory 260 of the PC 210 on the user's personal network (page 5, lines 25-27). The memory 280 in the peripheral device 220 is partitioned into two portions. Each of the portions of the peripheral device 220 memory 280 is

configured to store a firmware upgrade. The PC 210 is configured to determine if the peripheral device requires a firmware upgrade by comparing the version of the firmware update stored in the memory 260 of the PC 210 to the version of the firmware upgrade stored in the peripheral device 220 memory 280. If it is determined that a firmware upgrade is required, the peripheral device determines whether to transfer the firmware upgrade stored in the memory 260 of the PC 210 to the first portion or the second portion of the peripheral device 220 memory 280 (page 3, lines 8-14; page 6, lines 4-31). Thereafter the firmware upgrade stored in the memory 260 of the PC 210 is transferred and installed in the appropriate portion of the peripheral device 220 memory 280.

The 413' Reference

Generally, the 413' reference discloses a library search software for searching a document library contained on a disk. In operation, the 413' reference teaches that "the document library searches for matching documents when prompted by the user. If the user wishes to check for new documents entered in to the library, then the method retains this request if no match is found, and e-mails the user if a matching document is updated later." See Basic-Abstract section. However, the 413' reference does not discuss anything more about the e-mail, and in particular the content of the e-mail.

The Hunt Reference

Generally, Hunt discloses a technique for controlling a plurality of automatic data collection device platforms (Abstract). Each ADC device platform contains an ADC device server. The ADC device server connects to a communication network that may be remotely accessed by an ADC device operator. The remote ADC device operator sends commands for controlling the ADC device over the communication network and through the server to the ADC device (col. 2, lines 9-25). Hunt discusses utilizing applets to provide the user interface for the system management unit and to provide communication between the system management unit and ADC device (col. 9, lines 1-4). However, the ADC device platform uses system management support utilities to perform file transfer, application installation and firmwear upgrades (col. 9, lines 44-47, col. 7, lines 32-35).

The Sugiarto Reference

Generally, Sugiarto discloses a technique that allows users to purchase large content files from a source, such as an internet content provider, and select various times to download the content files to the users' computers.

The Nakao Reference

Generally, the Nakao reference discloses a technique for managing office automation devices.

Response to the §103 Rejections

Claims 1, 2, 6, 7 and 10-14 stand rejected under 35 U.S.C. § 103(a) as being obvious in view of the combination of International Publication No. WO 00/17749 to Mattingly and Derwent Abstract Pub. No. 413041A (referred to hereinafter as the 413' reference). In response, the Applicants respectfully traverse the rejection.

Claim 1 recites a method of upgrading firmware on a computing device comprising:

- determining a current version of firmware installed on the computing device;
- searching a predesignated location for a firmware upgrade;
- sending an email notification to one or more predesignated email addresses if the firmware upgrade is found, wherein the email notification includes a selectable option operable by a user; and
- installing the firmware upgrade onto the computing device in response to selection of the selectable option.

The Applicants submit that the Office has failed to establish a motivation sufficient for one of ordinary skill in the art to modify the teachings of Mattingly with the teachings of the 413' reference. The Office's reasoning for combining Mattingly with 413' in rejecting Claim 1 is:

It would have been obvious to a person of ordinary skill in the art to modify the teachings of Mattingly to show sending an email notification to one or more pre-designated email addresses if the firmware upgrade is found. This would have advantageously notified users on a network when firmware upgrades were available for the computing device.

However in the Mattingly reference, there is no need to notifying the user when a firmware upgrade is available. Mattingly, teaches that the "firmware upgrade process includes storing an updated firmware versions in memory 260, as received from an external data source, e.g., from a CD-ROM disk read from CD-ROM drive 270." See page 5, lines 25-28. Thus, the user already knows that the firmware upgrade is available because the user loaded the CD-ROM into CD-ROM driver 270 of the PC 210 in their personal network 100. Therefore, the teachings of Mattingly refute the motivation advanced by the Office.

Applicants therefore respectfully submit that without a motivation to combine the rejection based on a prima facie case of obvious is improper (MPEP 2143.01).

Accordingly, Applicants request that the §103(a) rejection of Claim 1 be withdrawn and Claim 1 be allowed.

Claims 2, 6, 7 and 10-14 are allowable by virtue of their dependency on respective base Claim 1, as well as the additional elements they recite. Accordingly, Applicants respectfully request that the §103(a) rejection of Claims 2, 6, 7 and 10-14 be withdrawn and Claims 2, 6, 7 and 10-14 be allowed.

Claims 3, 4, 21, and 24-26 stand rejected under 35 U.S.C. § 103(a) as being obvious in view of the combination of International Publication No. WO 00/17749 to Mattingly, Derwent Abstract Pub. No. 413041A (referred to hereinafter as the 413' reference), and U.S. Patent No. 6,539,422 to Hunt. In response, the Applicants respectfully traverse the rejection.

Claims 3 and 4 depend from Claim 1 and incorporate all the limitations therein. Accordingly, Claims 3 and 4 are allowable by virtue of their dependency on Claim 1, as well as the additional elements they recite. In particular, neither Mattingly, the 413' reference nor Hunt provide a suggestion or motivation to combine Mattingly and the 413' reference. In addition, the teachings of Mattingly refute the motivation advanced by the Office. Accordingly, Applicants respectfully request that the §103(a) rejection of Claims 3 and 4 be withdrawn and that Claims 3 and 4 be allowed.

Claim 21 recites a computing device comprising:

- firmware stored in nonvolatile memory on the computing device; and
- an upgrade applet configured to determine the current version of the firmware, search a predesignated location for a firmware upgrade, send an email notification regarding an available firmware upgrade, and install the available firmware upgrade in the nonvolatile memory.

The Applicants submit that the Office has failed to establish a motivation sufficient for one of ordinary skill in the art to modify the teachings of Mattingly with the teachings of the 413' reference. The Office's reasoning for combining Mattingly and the 413' reference in rejecting Claim 21 is:

"It would have been obvious to a person of ordinary skill in the art to modify the teachings of Mattingly to show sending an email notification to one or more pre-designated email addresses if the firmware upgrade is found. This would have advantageously notified users on a network when firmware upgrades were available for the computing device."

However in the Mattingly reference, there is no need to notifying the user when a firmware upgrade is available. Mattingly, teaches that the "firmware upgrade process includes storing an updated firmware versions in memory 260, as received from an external data source, e.g., from a CD-ROM disk read from CD-ROM drive 270." See page 5, lines 25-28. Thus, the user already knows that the firmware upgrade is

available because the user loaded the CD-ROM into CD-ROM driver 270 of the PC 210 in their personal network 100. Therefore, the teachings of Mattingly refute the motivation advanced by the Office. Accordingly, without a motivation to combine, the rejection based on a prima facie case of obvious is improper (MPEP 2143.01).

The Applicants also submit that the Office has failed to show that Mattingly, the 413' reference and Hunt teach each and every element of Claim 21. In particular, the Office only alleges that Hunt teaches "applets configured for determining device data." However, Hunt does not show and the Office has not provided a reference that shows applets configured to search a predesignated location for a firmware upgrade, applets configured to send an email notification regarding an available firmware upgrade, or applets configured to install the available firmware upgrade in the nonvolatile memory were well known in the art at the time of the present invention. Thus, of Mattingly, the 413' reference and Hunt do not teach each and every element of Claim 21.

For each of the reasons set forth above, Applicants respectfully submit that Claim 21 is patentable. Accordingly, Applicants request that the §103(a) rejection of Claim 21 be withdrawn and that Claim 21 be allowed.

Claims 24 and 25 are allowable by virtue of their dependency on respective base Claim 21, as well as the additional elements they recite. Accordingly, Applicants respectfully request that the §103(a) rejection of Claims 21 be withdrawn and that Claims 24 and 25 be allowed.

Claim 26 recites a computing device comprising:

- a computing device having an upgrade applet configured to locate a firmware upgrade and send an email notification regarding the firmware upgrade; and
- an email recipient configured to reply to the email notification, the reply comprising a user-designated time at which the upgrade applet will install the firmware upgrade onto the computing device.

The Applicants submit that the Office has failed to establish a motivation sufficient for one of ordinary skill in the art to modify the teachings of Mattingly with the teachings of the 413' reference. The Office's reasoning for combining Mattingly and the 413' reference in rejecting Claim 26 is:

"It would have been obvious to a person of ordinary skill in the art to modify the teachings of Mattingly to show sending an email notification to one or more pre-designated email addresses if the firmware upgrade is found. This would have advantageously notified users on a network when firmware upgrades were available for the computing device."

However in the Mattingly reference, there is no need to notifying the user when a firmware upgrade is available. Mattingly, teaches that the "firmware upgrade process includes storing an updated firmware versions in memory 260, as received from an

external data source, e.g., from a CD-ROM disk read from CD-ROM drive 270.” See page 5, lines 25-28. Thus, the user already knows that the firmware upgrade is available because the user loaded the CD-ROM into CD-ROM driver 270 of the PC 210 in their personal network 100. Therefore, the teachings of Mattingly refute the motivation advanced by the Office. Accordingly, without a motivation to combine, the rejection based on a prima facie case of obvious is improper (MPEP 2143.01).

The Applicants also submit that the Office has failed to show that Mattingly, the 413' reference and Hunt teach each and every element of Claim 26. In particular, the Office only alleges that Hunt teaches “applets configured for determining device data.” However, Hunt does not show and the Office has not provided a reference that shows “applets configured to send an email notification regarding an available firmware upgrade.”

Furthermore, the Office has not shown that any reference teaches or suggests “an email recipient configured to reply to the email notification, the reply comprising a user-designated time at which the upgrade applet will install the firmware upgrade onto the computing device.” Thus, Mattingly, the 413' reference and Hunt do not teach each and every element of Claim 26.

For each of the reasons set forth above, Applicants respectfully submit that Claim 26 is patentable. Accordingly, Applicants request that the §103(a) rejection of Claim 26 be withdrawn and that Claim 26 be allowed.

Claims 5, 9, 15-17 and 20 stand rejected under 35 U.S.C. § 103 as being obvious in view of the combination of International Publication No. WO 00/17749 to Mattingly, Derwent Abstract Pub. No. 413041A (referred to hereinafter as the 413' reference), and U.S. Patent Publication No. 2002/0143952 to Sugiarto. In response, the Applicants respectfully traverse the rejection.

Claims 5 and 9 depend from Claim 1 and incorporate all the limitations therein. Accordingly, Claims 5 and 9 are allowable by virtue of their dependency on Claim 1, as well as the additional elements they recite. In particular, neither Mattingly, the 413' reference nor Sugiarto provide a suggestion or motivation to combine Mattingly and the 413' reference. In addition, the teachings of Mattingly refute the motivation advanced by the Office. Accordingly, Applicants respectfully request that the §103(a) rejection of Claims 5 and 9 be withdrawn and that Claims 5 and 9 be allowed.

Claim 15 recites a method of upgrading firmware on a computing device comprising:

- predesignating a server location to be searched for a firmware upgrade;
- predesignating an email address to which an email notification will be sent when the firmware upgrade is found;

- receiving an email notification at the email address, the email notification comprising a selectable option configured to automatically install the firmware upgrade on the computing device from the server location.

The Applicants submit that the Office has failed to establish a motivation sufficient for one of ordinary skill in the art to modify the teaching of Mattingly with the teachings of the 413' reference. The Office's reasoning for combining Mattingly and the 413' reference in rejecting Claim 26 is:

"It would have been obvious to a person of ordinary skill in the art to modify the teachings of Mattingly to show sending an email notification to one or more pre-designated email addresses if the firmware upgrade is found. This would have advantageously notified users on a network when firmware upgrades were available for the computing device."

However in the Mattingly reference, there is no need to notifying the user when a firmware upgrade is available. Mattingly, teaches that the "firmware upgrade process includes storing an updated firmware versions in memory 260, as received from an external data source, e.g., from a CD-ROM disk read from CD-ROM drive 270." See page 5, lines 25-28. Thus, the user already knows that the firmware upgrade is available because the user loaded the CD-ROM into CD-ROM driver 270 of the PC 210 in their personal network 100. Therefore, the teachings of Mattingly refute the

motivation advanced by the Office. Accordingly, without a motivation to combine, a rejection based on a prima facie case of obvious is improper (MPEP 2143.01).

The Applicants also submit that the Office has failed to show that Mattingly, the 413' reference and Sugiarto teach each and every element of Claim 15. In particular, Sugiarto does not mention an "email notification" that includes "a selectable option." Instead, Sugiarto discusses that a list of content files are downloaded and that the user selects a content file for purchase and one of the available pricing options (page 2, paragraphs 0026-0027). Thus, Mattingly, the 413' reference and Sugiarto do not teach each and every element of Claim 15.

For each of the reasons set forth above, Applicants respectfully submit that Claim 15 is patentable. Accordingly, Applicants request that the §103(a) rejection of Claim 15 be withdrawn and that Claim 15 be allowed.

Claims 16, 17 and 20 are allowable by virtue of their dependency on respective base Claim 15, as well as the additional elements they recite. Accordingly, Applicants respectfully request that the §103(a) rejection of Claims 16, 17 and 20 be withdrawn and that Claims 16, 17 and 20 be allowed.

Claim 8 stands rejected under 35 U.S.C. § 103(a) as being obvious in view of the combination of International Publication No. WO 00/17749 to Mattingly, Derwent Abstract Pub. No. 413041A (referred to hereinafter as the 413' reference), and U.S. Patent Publication No. 2001/0054152 to Nakao. In response, the Applicants respectfully traverse the rejection.

Claim 8 depends from Claim 1 and incorporates all the limitations therein. Accordingly, Claim 8 is allowable by virtue of its dependency on Claim 1, as well as the additional elements it recites. In particular, neither Mattingly, the 413' reference nor Nakao provide a suggestion or motivation to combine Mattingly and the 413' reference. In addition, the teachings of Mattingly refute the motivation advanced by the Office. Accordingly, Applicants respectfully request that the §103(a) rejection of Claim 8 be withdrawn and that Claim 8 be allowed.

Claims 18, 19, 22 and 23 stand rejected under 35 U.S.C. § 103 as being obvious in view of the combination of International Publication No. WO 00/17749 to Mattingly, Derwent Abstract Pub. No. 413041A (referred to hereinafter as the 413' reference), U.S. Patent Publication No. 2002/0143952 to Sugiarto, and U.S. Patent No. 6,539,422 to Hunt. In response, the Applicants respectfully traverse the rejection.

Claims 18 and 19 depend from Claim 15 and incorporate all the limitations therein. Accordingly, Claims 18 and 19 are allowable by virtue of its dependency on Claim 15, as well as the additional elements they recite. In particular, neither Mattingly, the 413' reference, Sugiarto nor Hunt provide a suggestion or motivation to combine Mattingly and the 413' reference. In addition, the teachings of Mattingly refute the motivation advanced by the Office.

The Applicants also submit that the Office has failed to show that Mattingly, the 413' reference, Sugiarto and Hunt teach each and every element of Claim 15. In particular, Sugiarto does not mention an "email notification," that includes "a

selectable option.” Instead, Sugiarto discusses that a list of content files are downloaded and that the user selects a content file for purchase and one of the available pricing options (page 2, paragraphs 0026-0027).

Furthermore, Hunt does not show and the Office has not provided a reference that shows configuring an applet with a predesignated location or configuring an applet with an email address for receiving an email notification. Instead, Hunt only discusses applets configured for determining device data (col. 7, lines 13-42). Thus, Mattingly, the 413' reference, Sugiarto and Hunt do not teach each and every element of Claims 18 and 19.

For each of the reasons set forth above, Applicants respectfully submit that Claims 18 and 19 are patentable. Accordingly, Applicants request that the §103(a) rejection of Claims 18 and 19 be withdrawn and that Claims 18 and 19 be allowed.

Claims 22 and 23 depend from Claim 21 and incorporate all the limitations therein. Accordingly, Claims 22 and 23 are allowable by virtue of its dependency on Claim 21, as well as the additional elements they recite. In particular, neither Mattingly, the 413' reference, Sugiarto nor Hunt provide the suggestion or motivation to combine Mattingly and the 413' reference. In addition, the teachings of Mattingly refute the motivation advanced by the Office.

The Applicants also submit that the Office has failed to show that Mattingly, the 413' reference, Sugiarto and Hunt teach each and every element of Claims 22 and 23. In particular, Sugiarto does not mention an “email notification” that includes “a

selectable option.” Instead, Sugiarto discusses that a list of content files are downloaded and that the user selects a content file for purchase and one of the available pricing options (page 2, paragraphs 0026-0027). Sugiarto also does not mention an “email notification” that includes information such as “the current version of the firmware,” “the location of the available firmware upgrade,” “cost associated with the available firmware upgrade,” and “billing data required to complete an electronic commerce transaction to purchase the available firmware upgrade.”

Furthermore, Hunt does not show and the Office has not provided a reference that shows applets configured to search a predesignated location for a firmware upgrade, configured to send an email notification regarding an available firmware upgrade, or configured to install the available firmware upgrade in the nonvolatile memory were well known in the art at the time of the present invention. Instead, Hunt only discusses applets configured for determining device data (col. 7, lines 13-42). Thus, Mattingly, the 413' reference, Sugiarto and Hunt do not teach each and every element of Claim 22 and 23.


For each of the reasons set forth above, Applicants respectfully submit that Claims 22 and 23 are patentable . Accordingly, Applicants request that the §103(a) rejection of Claims 22 and 23 be withdrawn and that Claims 22 and 23 be allowed.

Conclusion

Applicants submit that the pending claims are in condition for allowance and respectfully requests that this application be allowed and forwarded on to issuance.

Respectfully Submitted,

Date: 12/29/05

By: 
Lewis C Lee
Reg. No. 34,656
Attorney for Applicants

Lee & Hayes, PLLC
421 W. Riverside Avenue, Suite 500
Spokane, Washington 99201
Telephone: (509) 324-9256
Facsimile: (509) 323-8979